

## REMARKS/ARGUMENTS

### *Status of the claims*

Claims 1 and 4 – 31 are pending in the application. Claims 25, 26, and 28 – 31 have been amended to comply with the Examiner's prior objections and to overcome the Examiner's prior rejections.

### *Objection to Affidavit under 37 CFR 1.131*

In his November 16, 2004 Office Action, the Examiner rejected claims 1 and 4-31 under 35 U.S.C. 103(a) as being unpatentable over Klatt et al., U.S. Patent No. 6,473,760, entitled "Apparatus for Printing Information Automatically Combined from Two Different Sources" in view of ImageX.com *SEC Filing* of 12 May 1999. OA, at 8. Klatt et al. was filed on January 10, 2000. It purports to be a continuation of 09/460,307, filed on December 13, 1999.

In the November 16, 2004 office action, the Examiner found the affidavit of Leonard H. Lopez Jr. filed on 23 August 2004 under 37 CFR 1.131 to be insufficient to overcome the Klatt reference for both procedural reasons and reasons of insufficiency of evidence. OA, at 2. First, the Examiner found that affidavits lacked the requisite NAFTA/WTO statement and lacked a statement regarding "willful false statements . . ." (See 37 CFR 1.68 and MPEP 715.07(c)). Secondly, the Examiner found the affidavit and supporting evidence insufficient to establish conception, actual reduction to practice, and diligence from a date prior to reduction to practice of Klatt to an actual reduction.

Applicant has amended his 1.131 affidavit to address the procedural concerns. Paragraph 1 now contains a "willful false statements . . ." clause and Paragraph 22 states that all acts to reduce this invention to practice were performed in the United States, a NAFTA country, or a WTO member country.

To overcome the Examiner's objections to the sufficiency of the prior submitted affidavits, the Applicant is submitting corroborating affidavits that show that his invention

worked for its intended purpose. To establish an actual reduction to practice requires a showing that the process actually worked for its intended purpose. Mahurkar v. C.R. Bard, Inc., 79 F.3d 1572, 1578 (Fed. Cir. 1996). The inventor must show independent corroborating evidence in addition to his or her own documents, such as testimony of a witness other than the inventor or evidence of surrounding facts and circumstances independent of information received from the inventor. Markman v. Lehman, 987 F. Supp. 25, 30 (D.D.C. 1997).

Under these guidelines, Applicant is submitting for consideration by the Examiner an affidavit from Norma Rodriguez, a procurement agent of a client, KCI, of the Applicant's company. This client attests that the documents attached as Exhibits to the aforementioned 1.131 affidavit result from a series of transactions that occurred during the months of June through October of 1999. This affidavit further asserts that during this timeframe, the attestee's company made use of the Applicant's invention to provide printed business cards.

Based on these newly submitted affidavits, Applicant respectfully requests that Examiner accept the declarations as sufficient under 37 CFR 1.131.

***Objection to Drawings/ Section 112, ¶ 1 Rejections***

Examiner objected to the drawings under 37 CFR 1.83(a) for failure to show the print provider interface (claims 30, 31), Order-approval interface (claims 28, 29), and profile management interface (claim 26). OA, at 5-6. Examiner also rejected claims 26 and 28-31 under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement because applicant had not described print provider interface, order-approval interface, and profile management interface. OA, at 7-8.

The print provider interface refers to the "processor interface 34" (Description, Page 7, Line 25). The order-approval interface and profile management interface refer to the "purchaser interface 33." Id.

Applicant has amended claims 26 and 28-31 by changing the terms print provider interface, order-approval interface, and profile management interface to provide proper antecedent references to the existing matter in both the drawings and the specification.

### ***Section 101 Rejections***

Examiner rejected claims 25-31 under 35 U.S.C. 101 as being non-statutory material. Examiner found that these claims did not describe functional material within the technological arts. OA, at 6-7. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. OA, at 7.

Applicant has amended claim 25 to clearly require the use of the technological arts for this claims and all of its dependent claims. This amendment in no way narrows the subject matter that the Applicant is claiming as his invention; it merely seeks to clarify that this method is implemented within the technological arts.

The print provider interface refers to the “processor interface 34” (Description, Page 7, Line 25). The order-approval interface and profile management interface refer to the “purchaser interface 33.” Id.

Applicant has amended claims 26 and 28-31 to provide proper antecedent references to the existing matter in both the drawings and the specification.

### ***Section 103 Rejections***

Examiner has rejected claims 1 and 4-31 under 35 U.S.C. 103(a) as being unpatentable over Klatt et al., U.S. Patent No. 6,473,760, entitled “Apparatus for Printing Information Automatically Combined from Two Different Sources” in view of ImageX.com *SEC Filing* of 12 May 1999. OA, at 8. Applicant has fully considered these prior art references in their entirety as requested by the examiner. Id.

Applicant respectfully asserts that the newly submitted evidence and 37 CFR 1.131 affidavits, as described above, shows an actual reduction to practice prior to the Klatt reference and hence overcomes the Examiner’s 103(a) rejection.

Alternatively, the Applicant asserts that there is no motivation to combine the prior art references in a manner which establishes the obviousness of the current invention. There must be a suggestion to combine the prior art in a manner which addresses all limitations of the claimed invention. Rather, Klatt suggests that the requisite combination would defeat the purpose of the Klatt invention.

The following capabilities are all required to accomplish the applicant's solution:

- 1) The ability to allow an institutional representative to define prototypical product records which include placement and typography – including tracking, kerning, and text adjustment information – for all informational elements, both textual and graphical, of the product record. This requirement is covered by Claim 1, ¶ 2; Claims 4-5; Claim 17; Claim 21, ¶ 3; Claims 22 and 23; and Claim 25, ¶ 3.
- 2) The ability for an institutional representative to establish a database to store all the informational elements required by the prototypical product records. Claims 6 and 8.
- 3) The ability to allow an institutional representative to provision user profiles that will define which products are available to each of the institution's employees. Claim 25, ¶¶ 1, 4, 6; Claim 26.
- 4) The ability to allow an institutional representative to define information fields that are controlled by the employee and information fields that are controlled by the institutional representative. Claims 10 and 11; Claim 21 ¶ 5.
- 5) The ability to allow each of institution's employees to individually access the system to define the content of his profile within the constraints established by the institutional representative and select and order a printable product within the constraints established by the institutional representative, and order the printable product. This system access should be done through a secure mechanism. Claim 1, ¶ 3; Claim 25, ¶¶ 5-9; Claim 27.

- 6) The ability to allow an institutional representative to modify, cancel, or approve an employee's orders prior to releasing the order to the printing provider. Claim 28-29.
- 7) The ability for the system to automatically generate a pre-press product incorporating the employee's information within the prototypical product layout established by the institutional representative. Claim 1, ¶ 4; Claim 21, ¶ 6; Claim 24; Claim 25, ¶ 10.

While the Klatt reference and the applicant's invention both address a method for providing a set of printable stationery products to a large, institutional customer in a manner which increases speed and efficiency, the current invention is patentably distinguishable from Klatt. Klatt is concerned with providing a computerized back-end system of event rules that will automatically determine when such materials will be printed and will automatically flow information from pre-established corporate databases into an electronic publishing application. Klatt, Col. 1, Lines 17-27. The Applicant's invention is concerned with providing a flexible, distributed front-end interface for ordering printed business materials to the ultimate end user of such material and combining this front-end system with an automated back-office systems. Description, at 4.

Furthermore, Klatt specifically teaches away from providing such a front-end system that allows for manual entry of personal data *by the employee*. Klatt expects information to be available from existing database sources and suggests that any ability to alter that information impinges upon the novelty of its solution. Specifically, Klatt states, "The print production request or requisition contains data directly extracted from the corporate database, rather than being manually entered by an employee." Klatt, Col. 3, Lines 39-42. In teaching away from the Applicant's front-end solution, the Klatt reference effectively defeats that need for a suggestion or motivation to combine Klatt with the SEC reference. Rather, it shows a demotivation to do so.

By teaching away from manual user control, Klatt teaches away from capability #5 above – the ability to allow each of an institution's employees to access the system. Klatt also necessarily teaches away from the combination of this capability with the other required capabilities of the system.

Therefore, applicant respectfully requests that the 103(a) rejection be withdrawn.

***Conclusion***

In view of the foregoing arguments, Applicants respectfully ask that all rejections be withdrawn. Believing that all things raised in the Examiner's November 16, 2004 office action have been addressed, the undersigned respectfully requests that the application be allowed and passed to issue.

Respectfully,

A handwritten signature in black ink, appearing to read 'C. Hanor', with a long horizontal line extending to the right.

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